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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/005,255   | 11/02/2001  | Irwin Kotovsky       | KOT0V-11            | 1332             |
| 7590   | 03/01/2004  |                      | EXAMINER            |                  |
| Ansel M. Schwartz<br>Suite 304<br>201 N. Craig Street<br>Pittsburg, PA 15213 |             |                      | WARD, JOHN A        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2875                |                  |
| DATE MAILED: 03/01/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                 |
|------------------------------|-----------------|-----------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)    |
|                              | 10/005,255      | KOTOVSKY, IRWIN |
|                              | Examiner        | Art Unit        |
|                              | John A. Ward    | 2875            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 January 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5,6,8-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5,6 and 15-17 is/are rejected.
- 7) Claim(s) 8-11,14 and 15 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 January 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## **DETAILED ACTION**

### ***Drawings***

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

No corrected drawings were included with the amendment.

### ***Claim Objections***

Claims 8, 9, 10, 11 and 14 are objected to because of the following informalities: these claims are dependent upon canceled claim 7 and will not be considered. Appropriate correction is required.

Claim 5 is objected to because of the following informalities: the claim is an incomplete sentence. Appropriate correction is required.

Claim 6 is objected to because of the following informalities: the term "merging means" is in an improper antecedent form. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutain (US 6,095,671) in view of Kelmelis et al (US 6,474,846).

Regarding claim 1, Hutain ('671) discloses lighting in a building structure comprising of a lighting fixture 206 having at least two lamps 174c, a one piece layer 210 having a plurality of holes 212, and the layer fitting into the building structure and defining a seam between the building structure and the layer 4 (figure 2D).

Regarding claim 2, Hutain discloses that the layer 4 has a front surface, and the layer has a shield 150a, 150c extending from the back surface disposed about each hole and the lamp are positioned at desired depths in the shield (Figure 2A and 2D).

Regarding claim 3, Hutain discloses a housing 108 that holds the lamp.

Regarding claim 5, it is an old and well known practice in construction to use tape along with Spackle to provide a smooth and clean mounting of the fixture to dry wall material in a building structure.

Regarding claim 6, Hutain discloses a universal mounting bracket 110.

Regarding claim 1, Hutain does not disclose Spackle disposed over the seam between the building structure and the layer.

Regarding claim 1, Kelmelis et al ('846) disclose a lighting system comprising of a housing 13 that housing a light source 83, a layer 41 fitting into the building structure and a spackle (column 3, lines 52-67, and column 4, lines 1-5).

Therefore it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the lighting fixture of Hutain with the

lighting fixture of Kelmelis et al in order to provide a means of provide a light fixture to mount to the ceiling with a flush mounting as taught by Kelmelis et al (abstract).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelmelis et al (US 6,474,846).

Regarding claim 15, Kelmelis et al discloses a lighting fixture comprising of one piece panel 41 that align with the lamp 83 and the light from the lamp can pass, fitting the panel into the building structure (figure 1), and securing the panel to the building structure 31, and column 3, lines 51-67, and column 4, lines 1-5 teaches how the spackle can be applied to provide connection between the panel and building structure.

Regarding claim 16, Kelmelis et al teaches that the lamp height can be adjusted (column 5, lines 50-61).

Regarding claim 17, Kelmelis et al teaches that the spackling is used to provide a means to attached the panel 41 to the building structure and it is an old and well know

practice in construction to use tape along with Spackle to provide a smooth and clean mounting of the fixture to dry wall material in a building structure.

Kelmelis does not disclose the method of lighting a building as set forth in claims 15-17 however it is inherent that each method step is met since each and every limitation is found in the prior art of Kelmelis.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 9, and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 19 and 26 of U.S. Patent No. 6,568,826. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader in scope than the claims of the prior art of record.

***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5-6, 8-11 and 14-17 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Ward whose telephone number is 571-272-2386. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. Ward  
Patent Examiner AU 2875

JAW  
February 18, 2004